



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/870,672  | 06/01/2001  | Ryota Sugimoto       | 018961-054          | 8651             |
| 39083   | 7590        | 09/07/2005           | EXAMINER            |                  |
| CERMAK & KENEALY, LLP<br>515 EAST BRADDOCK RD SUITE B<br>Alexandria, VA 22314 |             |                      | MATHEW, FENN C      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3764                |                  |
| DATE MAILED: 09/07/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4, 5, 9-13, 20, 22-23, 32-37, and 38-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley in view of Palmaz. Please refer to paragraphs 3-4 of the office action dated January 14, 2005. With respect to claim 32, based on the teachings of Palmaz it would have been obvious to one of ordinary skill in the art to provide grooves (deformable portions) on the bent portions of the Shanley device as discussed in the previous office action. In addition, claims 38-43 are substantially similar to previously presented claims discussing location of the deformable portions as well as angles of the deformable portions. Furthermore, in view of the teachings of Palmaz, it would have been obvious to one of ordinary skill in the art to choose any specific interval between adjacent grooves (Palmaz, page 8).
3. Claims 14-19 and 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanley in view of Palmaz as applied to claim 1 above, and further in view of Alt et al. (U.S. 5,788,979). Please refer to paragraph 5 of the above cited office action.

### ***Response to Arguments***

4. Applicant's arguments filed 06/25/2005 have been fully considered but they are not persuasive. Applicant has argued that a *prima facie* case of obviousness has not

Art Unit: 3764

been supported. Examiner respectfully disagrees as the teachings of Palmaz specifically cite the use of grooves on any portion of a stent. With regards to the annular configuration, Palmaz specifically states that it may be desirable to have symmetrical relationship between the grooves, or that one may form a serpentine pattern. One of ordinary skill in the art would have been inclined to utilize the teachings of Palmaz to meet the invention as claimed by the Applicant. One of ordinary skill in the art would have been inclined to provide grooves on any and all portions of a stent based on the teachings of Palmaz. Applicant has also argued that the grooves of Palmaz are meant for a different purpose, however Examiner respectfully points out that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3764

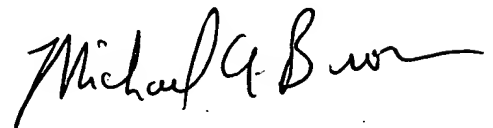
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fenn C. Mathew whose telephone number is (571) 272-4978. The examiner can normally be reached on Monday - Friday 9:00am - 5:30pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fcm  
September 5, 2005



MICHAEL A. BROWN  
PRIMARY EXAMINER